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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/655,853	05/30/1996	HAROLD A. MCMASTER	GLT-1540-R	9175
22045	7590	07/26/2004	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			VINCENT, SEAN E	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 07/26/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 82

Application Number: 08/655,853
Filing Date: May 30, 1996
Appellant(s): MCMASTER ET AL.

Earl J. LaFontaine
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed September 10, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct. Upon reconsideration,

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

Upon reconsideration, the examiner has decided to withdraw the rejection of claims 27 and 30 under 35 USC 112 paragraph 1. The only issue remaining on appeal is whether claim 27 constitutes recapture as described in the final rejection.

(7) *Grouping of Claims*

Claim 27 is the only claim on appeal.

(8) *Claims Appealed*

Claim 30 contain(s) substantial errors as presented in the Appendix to the brief. Accordingly, claim 30 is correctly written in the Appendix to the examiner's answer.

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(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim 27 is rejected under 35 U.S.C. 251. This rejection is set forth in prior Office Action, Paper No. 73.

(11) *Response to Argument*

In response to the argument that the applicant did not surrender the right to claim a tempering station in application 07/083,675 (not 07/083,685 as stated in the reply brief), the examiner disagrees. The Applicant is relying on the title and specification of the later filed application 07/249,718 (Pat 488527) to support allegations that an apparatus solely for tempering was not intended to be surrendered in the previously filed application 07/083,675. It is the position of the examiner that the subject matter cannot be “un – surrendered”. Moreover, removal of the claims to apparatus only for tempering constituted a surrender and subsequent filing of an application with no claims to apparatus only for tempering would reinforce the original surrender.

In response to the argument that claim 27 is narrower in scope than any of the cancelled quench claims, it should be noted that the test for recapture has been mischaracterized by the applicant. The test for recapture requires a comparison of the breadth of the reissue claims with the breadth of the patent claims to determine the presence of a broadening aspect. Further, claim 27 was established in the final rejection (paper no. 73) to be broader in one respect than the patented claims in one respect. That respect was further established to be germane to the prior

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art rejection of the canceled claims. The narrower aspects outlined by the applicant are not germane to the prior art rejection of the canceled claims.

Furthermore, it was suggested by the examiner in the personal interview of April 13, 1988 that the parent application would be allowable if (a) the claims directed to bending and tempering were amended as set forth in the interview summary form to define over the applied art and (b) the apparatus claims (claims 12-14) directed solely to tempering, also rejected on art, were canceled. The applicant then made the choice of canceling claims 12-14 which had been rejected over the Kahle patent, rather than appealing the rejection. Thus, the applicant chose not to prosecute further the claims directed to glass tempering while not reciting glass bending. Upon filing the child application, applicant chose not to provide and prosecute claims directed to glass tempering that omitted glass bending. Applicant is therefore not permitted to completely omit the bending of the glass. See *Pannu v. Storz Instruments, Inc.* 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Circ. 2001).

The decision in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel of the Board) is **not applicable** to the facts of this appeal.

In the present instance, the surrendered subject matter related to glass bending is entirely omitted from the broadened reissue claim 27. Such an omission in reissue claim 27 is a recapture of surrendered claim subject matter, even though reissue claim 27 includes other limitations making the reissue claim narrower than the patent claim in other aspects (not related to the bending of the glass). Referring to *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), the court pointed out that every time the claims are narrowed by amendment, subject

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matter is surrendered. *Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166 (“[E]very time Clement amended his claims, he intentionally omitted or abandoned the claimed subject matter.”). The cancellation of all claims directed to tempering without bending (when such claims were rejected over prior art) narrowed the scope of the application claims, such that a claim omitting bending of the glass was surrendered in response to a prior art rejection. The reissue claim 27 does narrow the patent claims in an area not related to the surrendered subject matter (in the area of tempering), however, as was held in *Pannu*, the narrowing in the reissue claim in an area not germane to what was surrendered (in response to the prior art rejection) cannot avoid recapture. The *Pannu* decision is relevant to the issue on appeal because it provides an actual fact situation in which this scenario was held to be recapture where the relied-upon limitation (to obtain the patent) is omitted, and replaced by an unrelated narrowing limitation. It was stated in *Pannu*, that “[o]n reissue, [the patent owner] is estopped from attempting to recapture **the precise limitation** he added to overcome prior art rejections.” (Emphasis added). In the present instance, the surrender was established by deleting the claims not having the critical bending limitation of the claim, rather than by adding the bending limitation to claims not originally containing such (which was the case in *Pannu*). It does not matter how the claims were amended to establish the surrender; in either case applicant cannot omit “the precise limitation” established as critical by amendment of the claims. Note that, in *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998), surrender and recapture were found to exist even where “the precise limitation” was established as the critical limitation without any amendment, where the critical limitation was relied upon via argument to define the invention over the prior art and was then omitted in the reissue claims. Thus, the manner in which

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amendment of the claims shows a limitation to be critical (in this case, by cancellation of all claims not having the critical limitation) does not change the fact that a claim omitting the critical limitation is being surrendered.

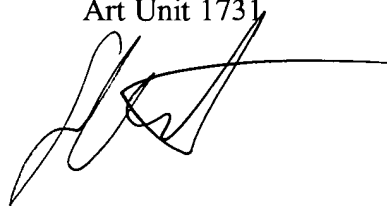
For the above reasons, it is believed that the rejections should be sustained.

APPEAL CONFEREES: 

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Respectfully submitted,

Sean E Vincent
Primary Examiner
Art Unit 1731



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February 5, 2004

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APPENDIX TO EXAMINER'S ANSWER

30. A glass sheet bending and tempering apparatus comprising: lower and upper opposed deformable platens each of which includes elongated quench tubes which extend in a spaced apart relationship to each other in the direction of conveyance of the glass sheet and have quench openings, the lower platen having deformable drive shafts which extend between the elongated quench tubes and are oriented to be generally transverse to the direction of travel of the glass sheet, and which deformable drive shafts are rotatably supported by those quench tubes, and the lower platen also having drive wheels supported on the deformable drive shafts thereof at spaced locations to engage and move the glass sheet to be bent; the upper platen having idler shafts mounted on the elongated quench tubes thereof and also having idler wheels mounted by the idler shafts at spaced locations to engage the glass sheet to be bent; actuating means for causing deformation of the lower platen with the upper platen being conformably deformable to the shape of the lower platen as the lower platen is bent from a flat shape to a bent shape with the glass sheet disposed between the platens as the quench openings of the elongated quench tubes and the wheels are moved with the platens as the wheels engage and bend the glass sheet; means to supply quenching gas to the quench openings of both platens after bending has finished to thereby temper the bent glass sheet between the platens; and drive means for driving the drive wheels to move the glass sheets during the bending and tempering of the glass sheet.